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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,378	01/27/2004	Anthony J. Baerlocher	112300-1869	4763

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BELL, BOYD & LLOYD LLP  
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CHICAGO, IL 60690

EXAMINER
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LEUNG, JENNIFER

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/767,378

Applicant(s)

BAERLOCHER ET AL.

Examiner

Jennifer Leung

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-40 is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-10, 17-21, 24-29, 31-36, 41, 43-63 and 68-79 is/are rejected.
- 7) ☒ Claim(s) 6-7, 11-16, 22-23, 30, 42 and 64-67 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/11/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

Page 18, line 14: "value set 114" should be -- value set 114b --.

Page 18, line 22: "value set 114a" should be -- value set 114b --.

Page 19, line 6: "value set 114b" should be -- value set 114a --.

Appropriate correction is required.

### *Claim Objections*

2. Claims 27-28, 30, 44, 48, 56-57, 64, and 68 are objected to because of the following informalities:

Claims 27 & 28, line 2: "the symbols" should be -- the selectable symbols --.

Claim 30, line 1: "said selections" should be -- said selectable symbols --.

Claim 44, line 23: "designated" should be -- indicated --.

Claim 48, line 9: "said primary wagering game" should be -- said primary game --.

Claim 56, line 4: "values sets" should be -- value sets --.

Claim 56, line 13: "the player" should be -- a player --.

Claim 57, line 1: "a" should be -- said --.

Claims 64 & 68, line 3: "values sets" should be -- value sets --.

Appropriate correction is required.

Atta.  
1) ☒  
2) ☐  
3) ☒  
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PTOL-326 (

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 46-49 and 72-73 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas (US 6,190,255).

Re claims 46 and 72: Thomas discloses a gaming device (col. 1, lines 10-15) and a method of operating a gaming device (col. 22, lines 38-40), comprising: a plurality of outcomes (Fig. 9; col. 10, lines 40-45); a plurality of termination events (Fig. 9; col. 10, lines 60-65), wherein each of said termination events is associated with one of a plurality of mathematical formulas (col. 12, lines 45-55; col. 15, lines 1-25; col. 20, lines 35-45); a plurality of selections, wherein each of said selections is associated with one of said outcomes or one of said termination events (Figs. 8-9; col. 10, lines 61-67); a display device (col. 9, lines 50-55); and a processor operable with said display device to (Fig. 12): (a) cause one of said selections to be picked (col. 10, lines 61-67); (b) reveal said outcome or said termination event associated with said picked selection (col. 10,

Art Unit: 3714

lines 46-60; col. 11, lines 1-5); (c) repeat steps (a) to (b) until said termination event is revealed (col. 10, lines 61-67; col. 11, lines 1-6); (d) determine an award by applying the mathematical formula associated with said revealed termination event (col. 12, lines 45-55; col. 15, lines 1-25; col. 20, lines 35-45); and (e) provide a player said determined award (col. 2, lines 15-19).

Re claims 47 and 73: Thomas further discloses the gaming device, wherein said processor is operable to enable said selections to be picked by the player (Figs. 12 & 14; col. 10, lines 61-67; col. 17, lines 1-5).

Re claim 48: Thomas discloses a gaming device controlled by a processor (Fig. 12), said gaming device comprising: a primary game operable upon a wager by a player (col. 1, lines 37-61); a plurality of outcomes (Fig. 9; col. 10, lines 40-45); a plurality of termination events (Fig. 9; col. 10, lines 60-65), wherein each of said termination events is associated with one of a plurality of mathematical formulas (col. 12, lines 45-55; col. 15, lines 1-25; col. 20, lines 35-45); a plurality of selections, wherein each of said selections is associated with one of said outcomes or one of said termination events (Figs. 8-9; col. 10, lines 61-67); a triggering event associated with said primary wagering game, wherein after the occurrence of said triggering event (col. 5, lines 20-30): (a) one of said selections is caused to be picked (col. 10, lines 61-67); (b) said outcome or said termination event associated with said picked selection is revealed (col. 10, lines 46-60; col. 11, lines 1-5); (c) steps (a) to (b) are repeated until said termination event is

revealed (col. 10, lines 61-67; col. 11, lines 1-6); (d) an award is determined by applying the mathematical formula associated with said revealed termination event (col. 12, lines 45-55; col. 15, lines 1-25; col. 20, lines 35-45); and (e) the player is provided said determined award (col. 2, lines 15-19).

Re claim 49: Thomas further discloses the gaming device of claim 48, wherein the player is enabled to pick one of said selections (Figs. 12 & 14; col. 10, lines 61-67; col. 17, lines 1-5).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 74 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Olsen (US 6,110,043). The teachings of Thomas have been discussed above.

However, Thomas fails to disclose a data network or an internet.

Olsen teaches games that use a data network or an internet (col. 4, lines 54-60).

Art Unit: 3714

Therefore, in view of Olsen, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a data network or an internet in order to provide the player with a bonus game at a remote location.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-5, 8-10, 17-21, 24-29, 31-36, 41, 43-53, 56-57, 60-61, 68-69, 72-73, and 76-77 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9, 15-21, 27-28, and 35-36 of U.S. Patent No. 6,688,975. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application disclose the same subject matter as taught in the claims of the patent.

9. Claims 54-55, 58-59, 62-63, 70-71, 74-75, and 78-79 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 18-19, and 35-36 of U.S. Patent No. 6,688,975 in view of Olsen (US 6,110,043). The claims of patent '975 disclose the same subject matter as the claims in the present application except for the use of a data network or an internet. Olsen teaches games that use a data network or an internet. Therefore, in view of Olsen, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a data network or an internet in order to provide the player with a bonus game at a remote location.

***Allowable Subject Matter***

10. Claims 27-28, 44, 56-57, and 68 would be allowable if rewritten or amended to overcome the objection(s), and if a terminal disclaimer is filed to overcome the double patenting rejection, set forth in this Office action.

11. Claims 30 and 64-67 would be allowable if rewritten or amended to overcome the objection(s), set forth in this Office action.

12. Claims 1-5, 8-10, 17-21, 24-26, 29, 31-36, 41, 43, 45, 50-55, 58-63, 69-71, and 76-79 would be allowable if a terminal disclaimer is filed to overcome the double patenting rejection, set forth in this Office action.

Art Unit: 3714

13. Claims 6-7, 11-16, 22-23, and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 37-40 are allowed.

15. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to show a gaming device comprising components and a method comprising steps as set forth in the independent claims 1, 19, 25, 31, 33, 35, 37, 39, 41, 44, 50, 52, 56, 60, 64, 68, and 76. In particular, the prior art fails to disclose a combination of the following claim limitations: "a value order associated with each value set", "at least one outcome associated with each value set", "display the value sets" before "input to be made", and "a multiple value outcome".

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fields discloses an apparatus and method for generating number sets. Neiderlein discloses a coin-operated entertainment machine. Goossens discloses a gaming table layout, and method for playing a high-low game. McGinnis ('333 and '377) discloses a method of playing a wagering game. Thomas ('074 and '930) discloses a bonus game for a gaming machine. Kaminkow discloses an apparatus and method for modifying generated values to determine an award in a gaming device.


Art Unit: 3714


Hughes-Baird discloses a gaming device having multiple selection large award bonus scheme.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Leung whose telephone number is 571-270-1342. The examiner can normally be reached on Mon -Thur, every other Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jennifer Leung  
March 1, 2007

  
Robert E. Pezzuto  
Supervisory Patent Examiner  
Art Unit 3714